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SEP 25 2006

Atty Dkt. No.: 10031531-1
USSN: 10/813,331

REMARKS

In view of the above amendments and the following remarks, the Examiner is requested to allow claims 1-16, the only claims pending and under examination in this application.

Claims 7, 8, 10, and 11 have been amended to be dependent on preceding claims.

No new matter has been added.

Claim Objections

Claims 7, 8, 10, and 11 were objected to for not depending upon a preceding claim, or in the case of Claim 11, for depending upon itself.

Present Claims 7, 8, 10, and 11 now depend upon preceding claims. This objection may be withdrawn.

Claim Rejections – 35 U.S.C. § 112, second paragraph

Claim 11 was rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite for lacking antecedent basis in Claim 1 for the phrase *a stratified fluid interface*. This rejection is respectfully traversed.

Original Claim 11 as filed did not depend upon Claim 1. Dependence upon Claim 1 was assumed by the Examiner for purposes of examination. Present Claim 11 depends upon Claim 9, which contains the requisite antecedent basis for the phrase at issue.

Withdrawal of this rejection is respectfully traversed.

Claim Rejections – 35 U.S.C. § 102(b)

Claims 1 and 11-14 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Goldberg et al. (U.S. Patent No. 5,959,098) ("Goldberg"). This rejection is respectfully traversed.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

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Verdegaal Bros. v. Union Oil of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Moreover, an anticipation rejection that is based on inherency must be supported by factual and technical grounds establishing that the inherent feature must flow as a necessary conclusion, not simply a possible conclusion, from the teaching of the cited art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990); *In re Oelrich*, 666 F.2d 578, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981).

Claim 1 recites in pertinent part *displacing said deblocking fluid ... with a wash fluid*. The Examiner asserted that Goldberg teaches "removing deblocking fluid from said deblocked surface by displacing said deblocking fluid from said surface with a wash fluid." Office Action at page 5.

In fact, Goldberg does not use the word *displacing*. Goldberg discloses wash solutions at columns 15 and 16. One would reasonably understand that wash solutions are used for washing. However, as defined in Applicants' specification at pages 32 and 33, displacing or purging with a wash fluid is a much more complex procedure than mere washing. Displacement of the deblocking fluid in the context of the present invention involves flowing a wash fluid across the substrate surface in a manner that produces a defined interface between the wash fluid and the deblocking fluid, which defined interface is maintained as it moves across the substrate surface and the deblocking fluid is concomitantly displaced therefrom. Further, the flow rate of the wash fluid is selected so as to achieve minimal mixing of the wash fluid and the deblocking fluid as the deblocking fluid is displaced or purged from the substrate surface.

Applicants' claimed invention is directed, *inter alia*, to removing a deblocking fluid from a substrate. As set forth above, the deblocking fluid is removed from the substrate by being displaced or pushed with a purging fluid while maintaining a defined interface between the two fluids. The purging fluid is then removed from the surface by using any convenient fluid removal protocol. The result is that the deblocking fluid is removed (e.g., via displacement) and the attached nucleoside monomers remain intact.

Contrariwise, in a washing process there is no defined interface between a wash fluid and whatever is being washed away by the wash fluid. Typically, the purpose of washing is the complete removal of a solid or liquid. Therefore, washing

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is a far less controlled process than is displacement, and there is mixing of the wash fluid and any fluid being washed away.

It is well established that during examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. MPEP § 2173.05(a). Applicants submit that to consider *displacing said deblocking fluid ... with a wash fluid* as reading on washing would be inconsistent with Applicants' specification.

Finally, if the Examiner considers that *displacing said deblocking fluid ... with a wash fluid* is inherently accomplished by a washing step, factual and technical grounds must be presented establishing that the inherent feature must flow as a necessary conclusion, not simply a possible conclusion, from Goldberg's teaching of washing.

Accordingly, each and every element of Applicants' claims is not described expressly or inherently in Goldberg. As such, there is no anticipation.

Withdrawal of this rejection is respectfully requested.

Claims 1, 7-9, 11, 15, and 16 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Dellinger et al. (U.S. Patent Application Publication No. 2002/0058802) ("Dellinger"). This rejection is respectfully traversed.

Claim 1 recites in pertinent part *displacing said deblocking fluid ... with a wash fluid*. The Examiner asserted that Dellinger teaches "removing deblocking fluid from said deblocked surface by displacing said deblocking fluid from said surface with a wash fluid." Office Action at page 6.

In fact, Dellinger does not use the word *displacing*. Dellinger discloses washing and wash solutions at paragraphs [0090], [0091], and [0103], for example. One would reasonably understand that wash solutions are used for washing. However, as defined in Applicants' specification at pages 32 and 33, displacing or purging with a wash fluid is a much more complex procedure than mere washing. Displacement of the deblocking fluid in the context of the present invention involves flowing a wash fluid across the substrate surface in a manner that produces a defined interface between the wash fluid and the deblocking fluid, which defined interface is maintained as it moves across the substrate surface and the deblocking fluid is concomitantly displaced therefrom. Further, the flow rate of the wash fluid is

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selected so as to achieve minimal mixing of the wash fluid and the deblocking fluid as the deblocking fluid is displaced or purged from the substrate surface.

Applicants' claimed invention is directed, *inter alia*, to removing a deblocking fluid from a substrate. As set forth above, the deblocking fluid is removed from the substrate by being displaced or pushed with a purging fluid while maintaining a defined interface between the two fluids. The purging fluid is then removed from the surface by using any convenient fluid removal protocol. The result is that the deblocking fluid is removed (e.g., via displacement) and the attached nucleoside monomers remain intact.

Contrariwise, in a washing process there is no defined interface between a wash fluid and whatever is being washed away by the wash fluid. Typically, the purpose of washing is the complete removal of a solid or liquid. Therefore, washing is a far less controlled process than is displacement, and there is mixing of the wash fluid and any fluid being washed away.

It is well established that during examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. MPEP § 2173.05(a). Applicants submit that to consider *displacing said deblocking fluid ... with a wash fluid* as reading on washing would be inconsistent with Applicants' specification.

Finally, if the Examiner considers that *displacing said deblocking fluid ... with a wash fluid* is inherently accomplished by a washing step, factual and technical grounds must be presented establishing that the inherent feature must flow as a necessary conclusion, not simply a possible conclusion, from Dellinger's teaching of washing.

Accordingly, each and every element of Applicants' claims is not described expressly or inherently in Dellinger. As such, there is no anticipation.

Withdrawal of this rejection is respectfully requested.

Claim Rejections – 35 U.S.C. § 102(e)

Claims 1, 9-11, and 16 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Sana et al. (U.S. Patent Application Publication No. 2005/0019786) ("Sana"). This rejection is respectfully traversed.

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Claim 1 recites in pertinent part *displacing said deblocking fluid ... with a wash fluid*. The Examiner asserted that Sana teaches "removing deblocking fluid from said deblocked surface by displacing said deblocking fluid from said surface with a wash fluid." Office Action at page 9.

In fact, Sana does not use the word *displacing*. Sana discloses washing and at paragraph [0075], for example. One would reasonably understand that washing is occurring despite the Examiner's assertion that movement of the fluid across the surface is being sensed.¹ However, as defined in Applicants' specification at pages 32 and 33, displacing or purging with a wash fluid is a much more complex procedure than mere washing. Displacement of the deblocking fluid in the context of the present invention involves flowing a wash fluid across the substrate surface in a manner that produces a defined interface between the wash fluid and the deblocking fluid, which defined interface is maintained as it moves across the substrate surface and the deblocking fluid is concomitantly displaced therefrom. Further, the flow rate of the wash fluid is selected so as to achieve minimal mixing of the wash fluid and the deblocking fluid as the deblocking fluid is displaced or purged from the substrate surface.

Applicants' claimed invention is directed, *inter alia*, to removing a deblocking fluid from a substrate. As set forth above, the deblocking fluid is removed from the substrate by being displaced or pushed with a purging fluid while maintaining a defined interface between the two fluids. The purging fluid is then removed from the surface by using any convenient fluid removal protocol. The result is that the deblocking fluid is removed (e.g., via displacement) and the attached nucleoside monomers remain intact.

Contrariwise, in a washing process there is no defined interface between a wash fluid and whatever is being washed away by the wash fluid. Typically, the purpose of washing is the complete removal of a solid or liquid. Therefore, washing is a far less controlled process than is displacement, and there is mixing of the wash fluid and any fluid being washed away.

¹ No disclosure of sensing movement across a surface appears in Sana in the paragraphs cited by the Examiner at page 9 of the Office Action.

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It is well established that during examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. MPEP § 2173.05(a). Applicants submit that to consider *displacing said deblocking fluid ... with a wash fluid* as reading on washing would be inconsistent with Applicants' specification.

Finally, if the Examiner considers that *displacing said deblocking fluid ... with a wash fluid* is inherently accomplished by a washing step, factual and technical grounds must be presented establishing that the inherent feature must flow as a necessary conclusion, not simply a possible conclusion, from Sana's teaching of washing.

Accordingly, each and every element of Applicants' claims is not described expressly or inherently in Sana. As such, there is no anticipation.

Withdrawal of this rejection is respectfully requested.

Claim Rejections – 35 U.S.C. § 102(b)/103

Claims 2-6 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as allegedly unpatentable over Dellinger et al. (U.S. Patent Application Publication No. 2002/0058802) ("Dellinger"). This rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation either in the cited references themselves or in the knowledge generally available to an art worker, to modify the reference or to combine reference teachings so as to arrive at the claimed method. Second, the art must provide a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations (MPEP § 2143). The teaching or suggestion to arrive at the claimed method and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure (MPEP § 2143 citing with favor, *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)).

The Examiner has made this additional rejection over Dellinger to assert that it would have been obvious that acetonitrile has a density lower than that of TCA. However, this assertion does not overcome the deficiency of Dellinger set forth

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above in the § 102(b) rejection over Dellinger. Namely, Dellinger does not use the word *displacing*. Dellinger discloses washing and wash solutions at paragraphs [0090], [0091], and [0103], for example. One would reasonably understand that wash solutions are used for washing. In a washing process there is no defined interface between a wash fluid and whatever is being washed away by the wash fluid. Typically, the purpose of washing is the complete removal of a solid or liquid. Therefore, washing is a far less controlled process than is displacement, and there is mixing of the wash fluid and any fluid being washed away.

Accordingly, for at least the reason that Dellinger does not teach or suggest all of the elements of Applicants' claims, there is no anticipation or *prima facie* obviousness.

Withdrawal of this rejection is respectfully requested.

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CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Timothy Joyce at (408) 553-2510.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10031531-1.

Respectfully submitted,



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